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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,848	02/05/2004	John M. Barrie	IPARA-08769	5758
David A. Casimir MEDLEN & CARROLL, LLP Suite 350 101 Howard Street San Francisco, CA 94105				
EXAMINER VAUGHN, GREGORY J				
ART UNIT 2178		PAPER NUMBER		
MAIL DATE 04/02/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/772,848

Applicant(s)

BARRIE ET AL.

Examiner

GREGORY J. VAUGHN

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Action Background

1. This action is responsive to the Request for Continued Examination, filed on 1/16/2008.
2. Applicant has amended claims 1, 2, 7 and 11. Claims 4 and 13 were previously canceled.
3. Claims 1-3 and 6-12 are pending in the case, claims 1 and 7 are independent claims.
4. A request for continued examination filed under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 7/16/2007) has been withdrawn pursuant to 37 CFR 1.114.
5. The rejection of claims 1-3 and 5-12, rejected under 35 U.S.C. 102(e) as being anticipated by Shanahan et al. US Patent Publication 2005/0022114, as described in the office action dated 7/16/2007, is withdrawn in view of the amended claims, however, new grounds of rejection are made, as described below.

Priority

6. As previously noted, applicant's claim for domestic priority under 35 U.S.C. 119(e) of US provisional application 60/447,379, filed 2/13/2003 is acknowledged.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. US Patent Publication 2005/0022114, filed 12/5/2001, published 1/27/2005 (hereinafter Shanahan).
9. **Regarding independent claims 1 and 7**, Shanahan discloses receiving a document over an electronic communication network. Shanahan recites: *"In one operational embodiment, multifunctional (i.e., fax, scan, print, store, email) device 512 scans in a document 614"* (paragraph 179). Shanahan discloses the multifunctional device 512 as part of an electronic communication network in Figure

5, reference sign 516 (shown as "Intranet"). Shanahan discloses converting the formatted document into a standardized formatted document. Shanahan recites: *"document content is detected and converted to a digital form"* (paragraph 179). Shanahan discloses permitting a user to add contextual markups to the formatted document to generate a markup document. Shanahan recites: *"Annotate" is used herein to mean to create a reference between an entity in a document, or region of a document, and some set of links, text segment, images, or embedded data"* (paragraph 117) and *"Document "mark-up" is used herein to mean the annotation applied to a document"* (paragraph 120). Shanahan discloses displaying the mark-up document. Shanahan recites: *"a visualization and interaction system that allows various levels of display and interaction of metadata-enhanced documents"* (paragraph 146).

Shanahan discloses adding contextual markups (described as annotate), as described above. Shanahan discloses user added annotations in a variety of forms, including *"text segments"*, as described above. Shanahan fails to explicitly describe the annotations as editorial comments, corrections, annotations, symbols or comments added by a user, however, editorial comments, corrections, annotations, symbols and comments are all text segments, and a user could use the text segment to contain editorial comments, corrections, annotations, symbols and comments. Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to use the annotation text segments, as taught by Shanahan for editorial comments, corrections, annotations, symbols and

comments in order *"to enrich the documents while facilitating reading comprehension, understanding relationships with other documents, and content creation"* (Shanahan, paragraph 3).

10. **Regarding dependent claims 2, 8, 9 and 11**, Shanahan discloses the standardized document as an image file (claims 2 and 11) as a manuscript (claim 8) and an educational assignment (claim 9). Shanahan recites: *"A "document" is used herein to mean an electronic (e.g., digital) or physical (e.g., paper) recording of information. In its electronic form, a document may include image data, audio data, or video data. Image data may include text, graphics, or bitmaps"* (paragraph 119) and *"continuous-education document service request. For example, a textbook document"* (paragraph 145)
11. **Regarding dependent claims 3 and 12**, Shanahan discloses the contextual markups are added to an invisible image that maps to said image file. Shanahan recites: *"A meta-document 100, for example, may be given a personality 104 that is: ... (c) private: marked to keep the document's metadata invisible to other documents"* (paragraph 149).
12. **Regarding dependent claim 5**, Shanahan discloses storing information related to the document in a database. Shanahan recites: *"FIG. 45 is a flow diagram for creating and updating an entity database dynamically from the document information space"* (paragraph 59).

13. **Regarding dependent claim 6**, Shanahan discloses the information consisting of an identifier of a submitter. Shanahan recites: *"this invention relates to the use of a digitally readable personality identifier in a meta-document management system"* (paragraph 3).
14. **Regarding dependent claim 10**, Shanahan discloses the Internet in Figure 2 at reference sign 221.

Response to Arguments

15. Applicant's arguments filed 1/16/2008 have been fully considered but they are not persuasive.
16. Regarding the rejection of claim 1, applicant argues: *"Shanahan does not disclose converting submitted formatted documents to standardized formatted documents. Further, Shanahan does not teach the claim element of contextual markups comprising editorial comments, corrections, annotations, symbols and comments"* (page 4, fifth paragraph, of the response filed 1/16/2008). Applicant is directed to the rejection of claim 1, as described above. Shanahan discloses the conversion of formatted documents into standardized formatted documents, as described above. Shanahan discloses annotations in the form of text segments, and text segments could obviously contain editorial comments, corrections, annotations, symbols and comments, as described above.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Stephen S. Hong/
Supervisory Patent Examiner, Art
Unit 2178

/Gregory J. Vaughn/
Patent Examiner
March 24, 2008